

Amdt. dated Mar. 28, 2008
Reply to Office Action of January 8, 2008

JEONG *et al.*
Appl. No. 10/551,466

Amendments to the Drawings

Please replace originally filed FIG. 5 with the replacement FIG. 5A and FIG. 5B attached herewith.

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-8 and 14 are pending in the application, with claim 1 being the independent claim. Claims 9-13 are withdrawn in accordance with the Examiner's Restriction Requirement of October 15, 2007. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Support for the amendment to claim 1 can be found throughout the specification, e.g., in originally filed claim 5. Support for the amendment to claim 8 can be found throughout the specification, e.g., on page 3, lines 7-12. Claims 5, 6, 7, and 8 have been amended to be consistent with the Restriction Requirement of October 15, 2007. FIG. 5 has been resubmitted to more clearly reflect the data.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Misc. Matters

Applicants note that the Examiner has alleged that claim 14 has been cancelled in accordance with the Interview Summary of October 15, 2007. Applicants bring to the Examiner's attention that the Interview Summary incorrectly records the telephone interview of October 2, 2007. To alleviate any confusion, Applicants provide a history of the currently pending claims.

During the telephone interview of October 2, 2007, the Applicants explained to the Examiner the existence of two claim sets. The first claim set, containing claims 1-14, was originally filed with the application. The second claim set, submitted in an amendment during the PCT phase on July 25, 2005, contained claims 1-13. The second claim set only contained claims 1-13, because in the second claim set, claims 1 and 9 (found on pages 14 and 15 respectively) were amended. In accordance with PCT practice, amended pages 14 and 15 were resubmitted. Page 16 (which contains claim 14) was not amended, and thus it was not resubmitted. However, claim 14 was still pending. Thus, claims 1-13 from the first claim set, and claim 14 from the second claim set are pending.

During the telephone interview of October 2, 2007, Applicants informed the Examiner that claims 1-13 from the second claim set, marked as "amended July 25, 2005," and claim 14 from the first claim set, as originally filed should be examined.

The Examiner provided the Applicants with a Restriction Requirement and an Interview Summary on October 15, 2007, stating that claim 14 had been cancelled. Applicants notified the Examiner in their Reply to the Restriction Requirement that the Interview Summary was incorrect, noting that the "Examiner failed to include claim 14 in any of Groups I-IV." Reply to Restriction Requirement, Filed November 15, 2007, page 2, ¶3. Thus, it is the Applicants' position that a response to the Interview Summary was timely filed to correct this error.

The claims, as presented herein, include claims 1-14, with claims 1-9 and 14 currently pending. Applicants have included claim 14 as currently pending, since the claim was never cancelled, and a restriction has not been made on that claim. If the

Examiner is of the opinion that a restriction of claim 14 is appropriate, she is invited to issue a further restriction requirement.

Rejection under 35 U.S.C. § 112

Claim 8 was rejected under 35 U.S.C. § 112 as allegedly being indefinite because it recites an antisense oligonucleotide comprising the target sequence, and not the complement of the target sequence.

Claim 8 has been amended to read "...wherein the antisense oligonucleotide comprises a nucleotide sequence complementary to a portion or entire nucleotide sequence of c-myc gene." Upon consideration of the above, Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tullis (U.S. Pat. No. 4,904,582). Specifically, the Examiner alleged that Tullis discloses a 20 nucleotide phosphodiester molecule linked to PEG by an ester bond.

Claim 1 has been amended to recite the oligonucleotide "is covalently linked to the hydrophilic polymer via an acid cleavable linkage, . . ." Tullis teaches an ester linkage, which is not an acid cleavable linkage. The Office Action erroneously notes that an ester linkage is "disclosed in the instant specification as an acid-cleavable linkage (page 7, lines 7-12)." Office Action, page 4, last ¶. However, the section of the specification cited by the Examiner clearly distinguishes between several types of

linkages. Page 7, lines 7-12 of the originally filed specification are recreated below (emphasis added):

Linkage between the hydrophilic polymer and the oligonucleotide of the conjugate may be achieved by one selected from the group consisting of non-cleavable linkages including amide bond and carbamate linkage, acid-cleavable linkages including hydrazone bond, phosphoroamidate linkage and acetal bond, disulfide bond, ester bond, anhydride-cleavable linkage, and enzyme-cleavable linkage.

Thus, the specification discloses that acid-cleavable linkages include hydrazone bond, phosphoroamidate linkage and acetal bond linkages, and distinguishes these linkages from ester bonds. Tullis only discloses an ester bond, and therefore does not disclose an acid cleavable linkage. Since claim 1 requires an acid cleavable linkage, each and every element of claim 1 is not taught by Tullis. Thus, Tullis neither anticipates amended claim 1, nor claims 2-7 which depend from claim 1. Upon consideration of the above, Applicants respectfully request that the rejection of claims 1-7 under 35 U.S.C. § 102(b) be withdrawn.

Rejections under 35 U.S.C. § 103

Claim 8 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Raschella *et al.* (*Cancer Research*, 52:4221-4226 (1992)) and Tullis. Claim 1 features an acid cleavable linkage. As noted above, Tullis does not disclose an acid-cleavable linkage. Raschella does not cure the deficiencies of Tullis, since it also does not disclose an acid-cleavable linkage. Since each element of the proposed claim 1 is not present in either of the cited documents, the present invention cannot be obvious in light

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of these two documents. Upon consideration of the above, Applicants respectfully request that the rejection of claim 8 under 35 U.S.C. § 103 be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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